

Applicant : Richard S. Ginn
Appl. No. : 10/773,508
Examiner : Ann M. Schillinger
Docket No. : 15457.4018

REMARKS

Applicant has carefully considered the Office Action dated October 31, 20007. Claims 1, 2 and 10-15 have been rejected as being anticipated by Keith et al. Patent No. 6,805,695. The Examiner has placed primary reliance upon the disclosure of the Keith '695 patent at column 25, line 9 through column 26, line 46 and upon Figures 18A-18L. Applicant believes that this portion of the Keith patent is not prior art because the priority date for this subject matter in Keith '695 is later than Applicant's priority date of September 6, 2001, the present application being a continuation of application serial no. 09/947,785, now Patent No. 6,736,815.

Only three of the parent applications of Keith '695 have a filing date prior to September 6, 2001. They are application serial no. 09/685,401, filed October 10, 2000, now Patent No. 6,579,291; application serial no. 09/542,972, filed April 4, 2000, and provisional application serial no. 60/263,343, filed on January 21, 2001. None of these Keith parent applications contains the disclosure found starting at column 25, line 9 nor do they contain Figures 18A-18L. Rather, provisional application serial no. 60/263,343 contains, by comparison to Keith '695, a rather limited disclosure and does not contain figures with a higher number than Figure 12R, does not contain Figures 3E and 3F and the disclosure of Keith 695 beginning at column 21, line 12 is substantially different from that of the provisional application and the disclosure commencing at column 22, line 27 of Keith '695 is believed to be entirely new as compared with the provisional application.

The Keith '750 patent which issued on application serial no. 09/542,972 stops with Figure 16, does not contain Figures 3D-3F, and Keith '695 appears to have a disclosure commencing at column 22, line 7 which is entirely absent from Keith '750. The Keith '291 patent, which issued on application serial no. 09/685,401 extends only as far as Figure 12R, does not contain Figures 3E or 3F of the '695 patent and the disclosure commencing at column 21, line 12 of Keith '695 appears to be substantially different from the disclosure in Keith '291 and the disclosure starting at column 22, line 27 of Keith '695 appears to be totally absent from Keith '291. Thus, it is believed that the rejection of claims 1, 2 and 10-15 as anticipated by Keith '695 cannot stand. The separate rejections of claims 10-15 on different portions of the Keith '695 patent must fall as well since they are dependent claims and the selected portions of the Keith '695 patent which the Examiner references with regard to them are of no consequence without the disclosure commencing at column 25, line 9 of Keith '695 and Figures 18A-18L of Keith '695.

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Claims 4-6 have been rejected as unpatentable over Keith '695 in view of Schneiderman Published Application No. 2003/0032965. This rejection cannot stand because the portion of Keith '695 primarily relied upon is, as explained above, not prior art as to the present application. In addition, there is nothing in the parent applications of Keith having a priority date earlier than the priority date of the present application which could in any way be combined with the disclosure of Schneiderman. The so-called "fork" 100 of Schneiderman is, as disclosed in paragraph 38 of Schneiderman, actually an anatomic guide instrument which is used "to determine and insure the proper screw trajectory and to help determine the length of a bone screw to be used." This is the furthest thing from the Examiner's characterization of the Schneiderman anatomic guide as a "fork member to place (sic) traction of the vertebra and make it easier to insert the band." There is no band in Schneiderman and, simply put, his anatomic guide device is simply an adjunct to placement of screws in the spine. Thus, Schneiderman is completely uncombinable with any part of Keith and adds absolutely nothing to the non-prior art disclosure of Keith and adds absolutely nothing to the portion of Keith which is prior to the present application.

Claims 7-9 have been rejected as unpatentable over Keith '695 in view of Belef Published Application No. 2002/0147497. Once again, this rejection is based primarily on Keith '695 and the portion of Keith '695 primarily relied upon by the Examiner is, as explained above, not prior art. In addition, the Belef patent is directed to filling a space **inside** a spinal disc previously occupied by nucleus pulposa with a fill material to maintain the structural integrity of the disc. Thus, Belef has nothing to do with (a) placing a band around the outside of the annulus of a disc nor with (b) placing a material, as recited in claims 7 and 8 "between" a band and a disc nor with, as recited in claim 9, providing a band comprising a material for enhancing healing of damage to an annulus fibrosis. Simply stated, Keith '695 and Belef have nothing to do with each other regardless of whether one considers the prior art portion of Keith '695 or the non-prior art portion of that patent.

Claims 16-18 have been rejected as unpatentable over Keith '695. In this rejection, the Examiner attempts to combine the non-prior art portion of Keith comprising column 25, line 9 through column 26, line 46 and Figures 18A-18L with Figures 11A-11D and column 14, line 64 through column 15, line 49. A rejection which attempts to combine a non-prior art teaching, here the columns 25 and 26 disclosure of Keith '695 and Figures 18A-18L, with the prior art disclosure of Keith '695 shown at Figures 11A-11D and an entirely unrelated disclosure at column 14, line 64

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through column 15, line 49 of Keith '695 is plainly improper. It is also pointed that the disclosures in columns 14 and 15 of Keith have nothing to do with Figures 11A-11D, but rather that the disclosure in Keith '695 that runs from column 20, line 27 to column 21, line 12 has to do with Figures 11A-11H of Keith. Thus, in addition to improperly relying upon the non-prior art portion of Keith '695, this rejection is all mixed up. Furthermore, Figures 11A-11D of Keith '695 and the disclosure which does describe them have absolutely nothing to do with the method claimed in the present application. Claims 16-18, which depend directly or indirectly upon claim 1, recited a method in which the anterior region of a spinal disc is first accessed and then the step of "extending a distal end of an elongate member along a first lateral region of the disc around a **posterior** region of the disc to an opposite second lateral region of the disc" is performed. No such procedure is shown in the Figures 11A-11D of Keith '695. Rather, as shown in these figures, the disc is indicated by the numeral 50 and comprises the annulus 52 and the nucleus pulposus 54. Figures 11A-11D do not show passing anything around the "posterior region" of the disc as recited in claims 16-18, but rather show accessing the posterior region directly passing a loop in front of the posterior portion of the disc such that, as shown in Figures 11E and 11F, the legs of the loop can be used as a guide for screws which will be screwed into the annulus and those screws are coupled to pins 310 to cause compression of a disc and closure of fissures 56 and 58. It would be hard to imagine a disclosure more remote from the method recited in claims 16-18 which are directed to placing a band around the outer surface of the annulus.

In addition, for the record, it is pointed out that the Keith '750 patent has an entirely different disclosure such that Figures 11A and 11B of Keith '750 are totally different from Figures 11A and 11B of Keith '695. In addition, there are no Figures 11C and 11D in Keith '750.

In summary, it must be pointed out that there is absolutely no basis for the rejections of record in this application. Keith '695 is not, with regard to the portion primarily relied upon by the Examiner, prior art. The secondary references Schneiderman and Belef are utterly remote from the rejected claims and could not and cannot be properly combined with Keith '695 even if Keith '695 constituted prior art.

It is believed that this application is now in condition for allowance. Thus, a favorable action is respectfully solicited.

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The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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